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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,889	02/12/2001	Sadahiko Yamaoka	1232-4684	9633
27123	7590	11/02/2004	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/781,889

**Applicant(s)**

YAMAOKA ET AL.

**Examiner**

Robert M. Pond

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant canceled Claims 16-20 without prejudice or disclaimer and amended Claims 1-4, 6-9, and 11-14. All pending claims (1-15) were examined in this final Office Action. Changes to the Office Action pertain to the cancellation of Claims 16-20.

### ***Response to Arguments***

#### **Objection to Abstract**

The Applicant amended the Abstract to overcome the rejection. The objection is withdrawn.

#### **Rejection under 35 USC 112**

Applicant's arguments filed 26 July 2004 are persuasive. Rejection of Claims 3, 8, 11, and 13 under 35 USC 112 is withdrawn.

#### **Rejection under 35 USC 102(e)- independent claims**

Applicant's arguments filed 26 July 2004 have been fully considered but they are not persuasive. The Applicant argues in light of the amended independent claims (1, 6, and 11) that Barnes does not teach products being purchased at the plurality of bases.

Examiner response: Barnes discloses a plurality of buyers from an organization making product purchases using the system and method of Barnes,

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and discloses large organizations having hundreds or thousands of employees. Barnes further discloses "Although only one terminal is shown, hundreds or thousands of user terminals may be used in a large company, either at one location or at a plurality of distributed or remote locations or facilities." (please see at least col. 7, lines 48-5). The Examiner believes the Applicant is reading limitations into Barnes regarding a single buyer location.

Rejection under 35 USC 102(e)-dependent claims

Applicant's arguments filed 26 July 2004 have been fully considered but they are not persuasive. The Applicant argues the dependent claims (2, 4, 5, 7, 9, 10, 14, and 15) for the reasons noted for independent Claims 1, 6, and 11. The Examiner respectfully disagrees with the Applicant for the reasons noted above.

Rejection under 35 USC 103(a)

Applicant's arguments filed 26 July 2004 have been fully considered but they are not persuasive. The Applicant argues claims (3, 8, and 13) for the reasons noted for independent Claims 1, 6, and 11. The Examiner respectfully disagrees with the Applicant for the reasons noted above regarding the independent claims. Barnes teaches purchases at a plurality of bases and does not rely upon Business Wire for these teachings.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1-2, 4-7, 9-12, 14, and 15 are rejected under 35 USC 102(e) as being anticipated by Barnes et al. (Paper #5, patent number 5,970,475, hereinafter referred to as Barnes).**

Barnes teaches all the limitations of Claims 1-2, 4-7, 9-12, 14-16, 18, and 20. For example, Barnes discloses an online procurement system designed to support parts procurement (see at least Fig. 1 (10); col. 1, lines 5-17). Barnes further discloses:

- *A parts database*: multiple supplier databases (see at least Fig. 3 (16, 42, 44'); Fig. 4 (16); col. 8, line 60 through col. 27).
- *Designating means for parts*: (see at least Fig. 3 (42); col. 9, lines 51-59).
- *Searching and display*: (see at least Fig. 2 (26, 28, 30, 34, 42); col. 6, lines 33-65; col. 8, line 36-38).
- *Pricing database*: catalog pricing (see at least col. 4, line 15).
- *Designating means for pricing*: (see at least col. 9, lines 51-53).

- Display control means for displaying price: (see at least col. 4, lines 5-16).
- Price difference display control: displays pricing and discounts to purchasers; purchasing based on discounted prices negotiated with suppliers (please note examiner's interpretation: making purchases based on discounted pricing equates to cost-cutting) (see at least col. 4, lines 5-15).
- Database storing purchase record information: (see at least col. 8, lines 53-54).
- Database storing order status and price history of orders: all users can view status and history of orders and generate reports (please note examiner's interpretation: history contains price history) (see at least col.9, lines 49-50).
- Internet communications with web browser interface: (please note examiner's interpretation: Internet communication and web browser interface provide bulletin board functionality) (see at least col. 7, lines 11-13; 24-26; col. 9, lines 66-67).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 3, 8, and 13 are rejected under 35 USC 103(a) as being unpatentable over Barnes (Paper #5, patent number 5,970,475), in view of Business Wire (Paper #5, PTO-892, Item: U).**

Barnes teaches all the above as noted under the 102(e) rejection and teaches cost-cutting by displaying discounts and further teaches advantages of negotiated pricing, but do not disclose displaying control means for displaying prices higher or lower than a price. Business Wire teaches BuyerZone.com joining forces with Inc.com to provide multi-vendor catalog, quote services, and comparison shopping tools. Business Wire further teaches providing intelligent decision-making tools so users can conveniently compare and purchase products online and can request quotes from multiple suppliers using a few simple keystrokes (please note examiner's interpretation: receiving multiple quotes results in receiving multiple prices that will be the same or ranging from highest to lowest). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Barnes to display

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product pricing higher or lower as taught by Business Wire, in order to facilitate comparison shopping, and thereby help the purchases select the lowest price.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

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***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**703-872-9306** (Official communications; including After Final  
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is written over the printed name.

Robert M. Pond  
Patent Examiner  
October 27, 2004